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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,419	04/23/2001	Werner Blumenstock	Q63542	3448

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EXAMINER
NGUYEN, DUC M

ART UNIT	PAPER NUMBER
2685	//

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/839,419	BLUMENSTOCK ET AL.	
	Examiner	Art Unit	
	Duc M. Nguyen	2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *20 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to applicant's response filed on 1/15/04. Claims 1-19 are now pending in the present application. **This action is made final.**

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims **1-16** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Kuwabara** (US Pat. Number **6,065,136**) in view of **Wookey** (US Pat. Number **6,085,244**).

Regarding claim **1, Kuwabara** discloses a system for remote diagnosis of device troubles, wherein electronic mail (e-mail) messages for sending the instruction and receiving diagnosis results are utilized (see **Fig. 1** and **col. 5, line 63 - col. 6, line 35**), which would include all the claimed limitations except for a firewall. However, it is clear that the system as described by **Kuwabara** would work equally well in a system comprising a firewall as disclosed by **Wookey** (see **Fig. 3** and **col. 5, lines 16-37**), wherein the diagnosis results are also reported via e-mail messages (see **col. 4, lines 13-17** and **col. 22, lines 16-20**). Therefore, it would have been obvious to one skill in

the art to provide the above teaching of **Wookey** to **Kuwabara** for utilizing a system with a firewall as well, for security purpose.

Regarding claim **2,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the instruction comprises at least one function as claimed, for diagnosis purpose.

Regarding claim **3,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would discloses the application comprises a component (hardware) as claimed, in order to run an application.

Regarding claim **4,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the first and second E-mail messages as claimed, in order to send the instruction and receive diagnosis results for diagnosis purpose.

Regarding claim **5,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the configuration as claimed, for diagnosis purpose.

Regarding claim **6,** the claim is rejected for the same reason as set forth in claim 5 above. In addition, it would have been obvious to one skill in the art to modify the above teachings of **Wookey** and **Kuwabara** for encrypting/decrypting e-mails as claimed, for security purpose as disclosed by **Wookey** (see col. 10, lines 34-43, 55-65).

Regarding claim **7,** the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the identification field and text field as claimed (see **Kuwabara**, Figs 3-4).

Regarding claim **8,** the claim is rejected for the same reason as set forth in claim 7 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the address, sender, date and time, and text fields as claimed (see Figs 3-4), for administration purpose.

Regarding claims **9-16,** the claims are interpreted and rejected for the same reason as set forth in claims 1-8 above.

Response to Arguments

Applicant's arguments filed 1/20/04 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., differences as argued by Applicant on pages 11-14 such as automatic execution of the diagnostic program upon receiving the first e-mail message) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Here, since the limitation "an instruction decoder which automatic identifies the instruction in the first e-mail message" as recited in claims 1, 9, 13, 16 does not interpret nor imply the limitation of automatic execution of

the diagnostic program upon receiving the first e-mail message. Therefore, even thought the diagnostic program is manually executed by the user as argued by the Applicant, it is clear that upon the execution of the inspection program by the user, the computer (automation system) in Kuwabara's reference would **inherently** include an instruction decoder and would automatic **identifies** the instructions of the inspection program in order to carry out the inspection process, this would read on the limitation ""an instruction decoder which automatic identifies the instruction in the first e-mail message" as claimed.

For foregoing reasons, the examiner believes that the pending claims are not allowable over the cited prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. **Any response to this final action should be mailed to:**

Box A.F.

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or communications from the examiner should be directed to Duc M. Nguyen whose telephone number is (703) 306-4531, Monday-Thursday (9:00 AM - 5:00 PM). Or to Edward Urban (Supervisor) whose telephone number is (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Duc M. Nguyen

Mar 23, 2004